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EXAMINER

OSORJO, RICARDO

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/777,185

Applicant(s)

QUESLATI ET AL.

Examiner

RICARDO L OSORIO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al (6,563,487) in view of Rosenberg et al. (US 2002/0113771).

Regarding claims 1 and 4, Martin teaches of a handheld computer comprising a housing (col. 7, lines 21-23), a display supported by the housing (Fig. 1a, reference character 34, and col. 7, lines 21-34); computing electronics (Fig. 1a, reference character 12) supported by the housing and configured to communicate with the display (col. 7, lines 31-33); and an integrated input device (Fig. 1a, reference character 18) configured to provide input to the handheld computer (col. 4, lines 14-16), the input device providing different input signals to the computing electronics dependent on a directional movement provided by a user (col. 4, lines 18-22), the input device configured to communicate more than four distinct directional movements from a user to the computing electronics (col. 4, lines 17-22 and 31-35. Note that just by having four directional positions and then pressing simultaneously two adjacent extensions to provide input for the appropriate diagonal direction between the extensions, more than four directional movements are being applied).

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However, Martin fails to teach of the integrated input device including a receptacle for coupling a graspable portion thereto, the input device providing input signals based on movement of the graspable portion when the graspable portion is coupled to the receptacle.

Rosenberg teaches of an input device including a receptacle (Fig. 5f, reference character 111a) for coupling a graspable portion (Fig. 5f, reference character 115) thereto, the input device providing input signals based on movement of the graspable portion when the graspable portion is coupled to the receptacle (see page 10, paragraph 121, lines 7-11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the graspable portion coupled in the receptacle, as taught by Rosenberg, in the device of Martin so that the user can move the stylus in degrees of freedom (see page 10, paragraph 212, lines 9-11) to be able to use the stylus in a manner that provides the benefits of using the joystick.

Regarding claim 2, Martin teaches that the integrated input device is a pad (col. 4, line 14).

Regarding claim 3, Martin teaches that the integrated input device is a button (col. 4, lines (col.4, lines 44-46).

3. **Claims 5-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view of Rosenberg as applied to claims 1-4 above, and further in view of Park et al (US 2002/0103616).

Regarding claim 5, Martin teaches of a display (Fig. 1a, reference character 34).

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However, Martin, as anticipated by Rosenberg, fails to teach that the display is a touch screen configured to be used with a stylus.

Parks teaches of a display screen (Fig. 1, reference character 14) being a touch screen (Fig. 1, reference character 13) configured to be used with a stylus (Fig. 1, reference character 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the touch screen, as taught by Parks, in the combined device of Martin and Rosenberg because hand held computing devices are well known in the art of computing devices to have widely adopted touch screen panels overlaid on a display screen wherein a stylus is employed to touch the screen at a selected location (see Parks, page 1, paragraph 2).

Regarding claim 6, Martin, as anticipated by Rosenberg, further fails to teach that at least a portion of the stylus is configured to be coupled to the integrated input device.

Park, further, teaches that the stylus is configured to be coupled to the integrated input device (see Parks, page 1, paragraph 9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the stylus coupled to the input device, as taught by Parks, in the combined device of Martin and Rosenberg in order to prevent accidental activation of touch screen components and to conserve battery power by monitoring more closely the present state of the hand held device (see Parks, page 1, paragraph 4).

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1. Claims 9 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis (5,790,100) in view of Rosenberg et al. (US 2002/0113771).

Regarding claim 9, first, the preamble mentions of a joystick device. However, the body of the claim does not breathe any life into the preamble mention of a joystick as to what is the purpose of the joystick in the invention. In other words, it does not specify how the joystick is related to the coupler or to the stylus. Thus, due to the breadth of the claim, the word joystick is not given any weight. Claim 9 is being rejected as follows:

Regarding claim 9, Kikinis teaches of a handheld computer (Fig. 1a, reference character 10, and col. 9, lines 55-58. Note that a subnotebook computer can be small enough to be held with the hand), comprising an input device (mouse, or trackball, Fig. 1H, reference character 17) integrated into the handheld computer (col. 1, lines 26-30, and col. 4, lines 46-53). Note, this mouse, or trackball, may be used both while in the well (Fig. 1H, reference character 16), or while not in the well.

However, Kikinis fails to teach in the embodiment above (hereafter, the first embodiment) the handheld computer configured to be used with a stylus.

Kikinis teaches in another embodiment (hereafter, the second embodiment) the handheld computer configured to be used with a stylus (col. 8, lines 63-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the handheld computer configured to be used with a stylus, as taught by the second

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embodiment of Kikinis, in addition to the device of the first embodiment of Kikinis because it provides a convenient way to input cursive writing and printing to the host computer (see Kikinis, col. 9, lines 4-6).

Also, Kikinis fails to teach of a coupler integrated into the input device configured to couple at least a portion of the stylus to the input device.

Rosenberg teaches of a coupler integrated into the input device configured to couple at least a portion of the stylus to the input device (see page 10, paragraph 121, lines 7-11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the coupler to couple a stylus to an input device, as taught by Rosenberg, in the device of Kikinis so that so that the user can move the stylus in degrees of freedom (see page 10, paragraph 212, lines 9-11) to be able to use the stylus in a manner that provides the benefits of using the joystick.

Regarding claims 12-15, further, Kikinis teaches that the input device is configured to communicate a directional input in, not only more than eight directions, but in a continuum of directions (see Kikinis, col. 1, lines 20-22, col. 4, lines 47-53, and col. 5, lines 28-35. Note that this is how a mouse or trackball control a cursor on a screen).

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2. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Rosenberg as applied to claims 9 and 12-15 above, and further in view of Kobayashi et al (6,563,493).

Regarding claim 10, the device of Kikinis, as anticipated by Rosenberg, fails to teach that the stylus has at least two sections a first section being configured to be coupled to a second section by a screw thread.

Kobayashi teaches of a stylus, or pen (Fig. 1, reference character 3) that has at least two sections a first section (Fig. 1, reference character 12) being configured to be coupled to a second section (Fig. 1, reference character 13) by a screw thread (col. 3, lines 40-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to couple a first section of the stylus to a second section by a screw thread, as taught by Kobayashi, in the combined device of Kikinis and Rosenberg so that when the tip is worn-out, the user himself can easily interchange the tip (col. 3, line 47-50).

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Rosenberg and Kobayashi as applied to claim 10 above, and further in view of Louis et al (Re 35,342).

Regarding claim 11, the device of Kikinis, as anticipated by Rosenberg, and Kobayashi, fails to teach of the coupler including a screw thread.

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Louis teaches of a stylus, or pen, coupler (Fig. 3, reference character 63) that includes a screw thread (Fig. 3, reference character 53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the stylus coupler including a screw thread, as taught by Louis, in the combined device of Kikinis, Rosenberg, and Kobayashi because screws are well known in general and in the art of joints and connections to be used to fasten pieces of solid material together.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Rosenberg, Kobayashi and Louis as applied to claim 11 above, and further in view of Martin et al (6,563,487).

The device of Kikinis, as anticipated by Carroll, Kobayashi and Louis, fails to teach of the input device being a joypad.

Martin teaches of the input device being a joypad (see Fig. 1a, reference character 18 and col. 4, lines 14, and 31-40. Note that this directional pad is used to move the cursor in different directions).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the joypad, as taught by Martin, in the combined device of Kikinis, Rosenberg, Kobayashi and Louis because the joypad can be alternatively used instead of the mouse, or trackball because all these devices are used for the same purpose: cursor control, object selection, etc (see Martin, col. 4, lines 35-45).

*Allowable Subject Matter*

5. Claims 17-24 are allowed.
6. Claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

4. Applicant's arguments with respect to claims 1-6, 9 and 12-15 have been considered but are moot in view of the new ground(s) of rejection.
12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricardo L. Osorio whose telephone number is (703) 305-2248. The examiner can normally be reached on Mon-Thu from 7:00 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala, can be reached at 305-4938.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231


**or faxed to: (703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ricardo L. Osorio  
Examiner  
Art Unit: 2673

RLO  
April 3, 2004

  
**BIPIN SHALWALA**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**